

REMARKS/ARGUMENTS

Applicants request that the entry of the RCE and accompanying amendment be treated as a request for withdrawal of Appeal No 2008-4423. *See*, MPEP 706.07(h)(X)(A) and 37 C.F.R. 1.116(d).

I. STATUS OF THE CLAIMS

With entry of this amendment, claims 1-48 are pending and claims 17-25 are withdrawn as being directed to a non-elected invention. Claims 1, 26, and 46 are amended. Support for the amendments can be found throughout the specification drawings, and claims as originally filed. Independent claims 1, 26, and 46 are amended to more clearly state the Applicant's invention. In particular, claim 46 is amended to clarify that "a body" refers to "a valve body." Claims 1, 26, and 46 are further amended to clarify that the fluid processing region and the fluid displacement region are contained within the valve body. Support for the amendments can be found throughout the specification, for example, at page 2, lines 3-6 which states:

In accordance with an aspect of the present invention, a fluid control and processing system comprises a housing having a plurality of chambers, and a valve body including a first fluid processing region continuously coupled fluidically with a fluid displacement region.

The above passage makes clear that the system is comprised of two parts, 1) a housing, and 2) a valve body. The valve body is then further characterized as including a fluid processing region, and a fluid displacement region. The placement of these fluidic regions within the valve body are evident from the drawings as originally filed (structures (30) and (50) as best seen in Figures 8 and 9). No new matter is added with entry of this amendment.

II. REJECTIONS UNDER 35 U.S.C. §102

Claims 1, 12, 26, 27, 30-32, 34-37, 42, 43, and 46 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Gundelfinger *et al.* (U.S. Pat. No. 4,068,528). The Examiner

cites Gundelfinger *et al.* as allegedly disclosing, *inter alia*, a liquid handling device, comprising a housing having a plurality of chambers (F1-F6) and a valve body including a first fluid processing region (30a) continuously coupled fluidically with a fluid displacement region (50). Applicants disagree.

In an effort to expedite the prosecution of the application, Applicants have amended independent claims 1, 26, and 46 to more clearly state that the fluid processing region is contained within the valve body.

Gundelfinger *et al.* clearly teaches that the fluid processing region is external to the valve body. Specifically, Gundelfinger *et al.* at col. 6, line 31 states "The sample loop 30, which is external to the valve..." emphasis added. The position of the sample loop as being outside of the valve body is also evident from the drawings in Gundelfinger *et al.* For example, Figure 4 of Gundelfinger *et al.* clearly shows sample loop (30) as being located external to the valve body.

Gundelfinger *et al.* does not anticipate the invention as presently claimed, because Gundelfinger *et al.* does not teach a liquid handling device where the fluid processing region and the fluid displacement region are contained within the valve body as presently claimed. Claims 12, 27, 30-32, 34-37, 42, 43 depend from independent claims 1 or 26 and include all of the limitations of the independent claim from which they depend. The arguments as presented above with regard to the independent claims are also applicable to the dependent claims.

In light of the claims as recited, and the arguments as presented above, Applicants request that the Examiner withdraw the rejection.

III. REJECTIONS UNDER 35 U.S.C. §103

A. Claims 2-11, 13-16, 28, 29, 33, 47 and 48 are patentable and not obvious over Gundelfinger *et al.* in view of Sakai *et al.* (U.S. Pat. No. 4,937,048).

Claims 2-11, 13-16, 28, 29, 33, 47 and 48 stand rejected as allegedly being unpatentable and obvious over Gundelfinger *et al.* in view of Sakai *et al.* The Examiner relies on the teaching of Gundelfinger *et al.* as discussed above with regard to the anticipation rejection, but acknowledges that Gundelfinger *et al.* fails to teach about the fluid processing material, such

as a solid phase material and comprising at least one liquid phase material. The Examiner alleges that Sakai *et al.* cures this defect in Gundelfinger *et al.*, and further alleges that it would have been obvious to a person of ordinary skill in the art to provide the fluid processing materials as taught by Sakai *et al.*, to the device as taught by Gundelfinger *et al.* to arrive at the Applicant's invention. Applicants disagree.

As discussed above with regard to the rejection under 35 U.S.C. §102(b), Gundelfinger *et al.* does not teach a device where the fluid displacement region and the fluid processing region are contained within a valve body as presently recited in independent claims 1, 26 and 46. Sakai *et al.* does not cure this defect. The Examiner has not established a proper *prima facie* case of obviousness because the cited references, neither alone nor combined, teach nor suggest all of the elements of the of the invention as presently recited in independent claims 1, 26, and 46. Therefore, the independent claims are patentable and not obvious over the cited references.

Claims 2-11, 13-16, 28, 29, 33, 47 and 48 depend either directly or indirectly from independent claims 1, 26 and 46, and include all of the limitations of the claims from which they depend. The arguments as presented above are also applicable to the dependent claims.

In light of the claims as amended, and the arguments as presented above, Applicants request that the Examiner withdraw the rejection.

B. Claims 38-41 are patentable and not obvious over Gundelfinger *et al.* in view of Lecerf *et al.* (U.S. Pat. No. 4,705,059)

Claims 38-41 stand rejected as allegedly being unpatentable and obvious over Gundelfinger *et al.* in view of Lecerf *et al.* The Examiner relies on the teachings of Gundelfinger *et al.* as discussed above with regard to the anticipation rejection, but acknowledges that Gundelfinger *et al.* does not teach or suggest a transmitting member coupled with the fluid processing region for transmitting energy. The Examiner alleges that Lecerf *et al.* cures this defect in Gundelfinger *et al.*, and further alleges that it would have been obvious to a person of ordinary skill in the art to provide a transmitting member as taught by Lecerf *et al.*, to

the device as taught by Gundelfinger *et al.* to arrive at the Applicant's invention. Applicant disagrees.

As discussed above with regard to the rejection under 35 U.S.C. §102(b), Gundelfinger *et al.* does not teach a device where both the fluid displacement region and the fluid processing region are contained within the valve body as presently recited in independent claim 26. Lecerf *et al.* does not cure this defect. Therefore, the cited references neither alone nor combined, teach or suggest all of the elements of the of the invention as presently claimed. Therefore, independent claim 26 is patentable over the cited references.

Claims 38-41 depend either directly or indirectly from independent claim 26, and include all of the limitations of independent claim 26. The arguments as presented above are also applicable to dependent claims 38-41.

In light of claim 26 are presently recited, and the arguments as presented above, Applicants request that the Examiner withdraw the rejection.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

/Robert C. Burrows/

Robert C. Burrows, Ph.D.
Reg. No. 61,039

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
RCB:rcb
61662045 v1